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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,817	09/26/2001	Gary Gomringer	70800.01	1182

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FISH & RICHARDSON PC
225 FRANKLIN ST
BOSTON, MA 02110

EXAMINER

WEBB, SARAH K

ART UNIT

PAPER NUMBER

3731

DATE MAILED: 01/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/963,817

Applicant(s)

GOMRINGER ET AL.

Examiner

Sarah K Webb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "...stent as taught in the prior art, said stent having..." in line 2 of claim 1 renders the claim indefinite, because the applicant is only claiming prior art here. This is an improperly written Jepson-type claim, where there is an admission of prior art. Examiner suggests rewriting the claim to include a statement of the claimed improvement over prior art.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

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2. Claims 1,2,5,9,11,12,15,19, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 6,022,374 to Imran.

Imran discloses a cylindrical stent with a plurality of struts (12), or expandable members. Holes (28) are formed in several of the struts (12), and radiopaque rivets (36) are mounted in the holes (28). The shape of the rivet (36) is most clearly shown in Figure 7. Imran explains that the radiopaque rivet (36) is formed of gold or platinum (column 3, line 19).

Regarding the method claim 21, Imran discloses the steps of forming holes in the struts (column 2, lines 64 through column 3, line 1) and mounting the radiopaque rivets in the holes (column 3, lines 30-56).

3. Claims 1,2,5,8,9,11,12,15,18, and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 6,231,598 to Berry et al.

Berry discloses a cylindrical stent that includes a plurality of struts, as shown in Figure 28. Holes (96) are formed in the struts, and radiopaque rivets (102,103,104) are mounted in the holes. Berry explains that the rivets are made of platinum, gold, or tungsten (column 19, lines 29-36). Figure 32 most clearly illustrates the shape of the radiopaque rivet that conforms to the shape of the hole (96) (column 20, lines 18-28).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3,4,6,7,10,13,14,16,17, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imran in view of US 6,355,058 to Pacetti et al.

Imran includes all the limitations of claims 3,4,6,7,13,14,16,17, but fails to form the radiopaque rivets of osmium, palladium, rhenium, or tantalum. Imran does include gold and platinum as materials for the rivets. Pacetti discloses a stent with radiopaque materials included in the structure. Pacetti teaches that many radiopaque materials are appropriate for use with stents, such as tungsten, rhenium, osmium, palladium, gold, platinum, and tantalum (column 5, lines 30-37). Regarding claims 10 and 20, Imran includes all the limitations of these claims, except for forming the rivet from a combination the materials listed above. Pacetti teaches that the radiopaque material used with the stent can be a compound of the metals listed (column 4, line 22-23). It would have been obvious to one of ordinary skill in the art to form the rivets of Imran from other radiopaque materials, such as osmium, palladium, rhenium, tantalum, or combinations thereof, as taught by Pacetti, because these materials are considered to be equal substitutes for gold and platinum.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent No. 6,334,871 to Dor et al. discloses a stent with radiopaque rivets, as most clearly shown in Figure 4, where the rivets are formed of gold, platinum, or tantalum. US 6,464,720 to Boatman et al. is a patent related to the Berry '598 reference.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarah K Webb whose telephone number is (703) 305-7554. The examiner can normally be reached on 8am-4:30pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Milano can be reached on 703-308-2496. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-3590 for regular communications and (703) 305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

Sarah K Webb
Examiner
Art Unit 3731

SW
January 24, 2003



Michael Milano
Supervisory Patent Examiner
Art Unit 3700